

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of:

JOEL E. SHORT et al.

Group Art Unit: 2664

Examiner: Patel, Ajit

Serial No.: 09/684,937

Filed: October 6, 2000

For: SYSTEM AND METHOD FOR ESTABLISHING NETWORK
CONNECTION WITH UNKNOWN NETWORK AND/OR
USER DEVICE

Attorney Docket No.: NOMI 0119 PUS

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. § 1.97(b)**

Mail Stop RCE
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In compliance with the duty of disclosure under 37 C.F.R. § 1.56 and §§ 1.97-1.98, the 17 references listed and identified on the attached Form (PTO/SB08 equivalent) are being submitted herewith for consideration by the Examiner. This Statement is being filed in accordance with 37 C.F.R. § 1.97(b)(1).

The Applicant wishes to bring to the Examiner's attention that the above-identified application claims priority under 35 U.S.C. § 120 to U.S. Application Serial No. 09/041,534 now U.S. Patent No. 6,130,892. A reexamination request was filed on

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

March 31, 2005
Date of Deposit

James N. Kallis
Name of Person Signing

[Signature]
Signature

February 15, 2005 (Reexam Control No. 90/007,423) for the '892 patent. In addition, the '892 patent is currently involved in the following litigation in the Southern District of California:

IP3 Networks, Inc. v. Nomadix, Inc., Case No. 04 CV 1485 BTM (POR)

The pleadings for this case, along with documents identified by IP3 Networks, are submitted herewith. In the litigation, IP3 Networks has alleged the following about the '892 patent:

(1) The Claim is anticipated under 35 U.S.C. § 102:

Claim 1 of the '892 patent is anticipated by the prior art. For example, Network Working Group Request For Comments: 925 - Multi-LAN Address resolution (October 1984), teaches each and every element of claim 1 of the '892 patent either explicitly or inherently. To the extent such reference does not anticipate a claim element, it renders the claim obvious under 35 U.S.C. § 103.

(2) The Claim is obvious under 35 U.S.C. § 103:

Claim 1 of the '892 patent is rendered obvious under § 103 based on the prior art. For example, each of the following references, taken individually or in combination with one or more other references, renders obvious at least claim 1 of the '892 patent.

- * Network Working Group Request For Comments: 1919 - Classical Versus Transparent IP Proxies (March 1996);

- * Network Working Group Request For Comments: 894 - Standards For Transmission of IP Datagrams Over Ethernet Networks (April 1984);

- * Network Working Group Request For Comments: 1009 - Requirements For Internet Gateways (June 1987);

- * Network Working Group Request For Comments: 1945 - Hypertext Transfer Protocol-HTTP/1.0 (May 1996);

- * Network Working Group Request For Comments: 1531- Dynamic Host Configuration Protocol (October 1993);
- * Network Working Group Request For Comments: 1034 - Domain Names - Concepts and Facilities (November 1987);
- * Network Working Group Request For Comments: 1631- The IP Network Address Translator (NAT) (May 1994);
- * Network Working Group Request For Comments: 826 - Ethernet Address Resolution Protocol (November 1982);
- * Network Working Group Request For Comments: 925 - Multi-LAN Address resolution (October 1984); and
- * Network Working Group Request For Comments: 1027 - Using ARP to Implement Transparent Subnet Gateways (October 1987).

(3) The Claim is invalid under 35 U.S.C. § 112:

IP3 Networks has also alleged that the claims of the '892 patent are invalid under § 112 first and second paragraph. IP3 Networks identified the following as infirmities in the claims:

The claim term "foreign network" is indefinite and lacks support in the written description.

The claim term "network settings" is indefinite and lacks support in the written description.

The claim term "intercepting packets transmitted from the user device" is indefinite and lacks support in the written description.

The claim term "subsequently transmitted packets" is indefinite and lacks support in the written description.

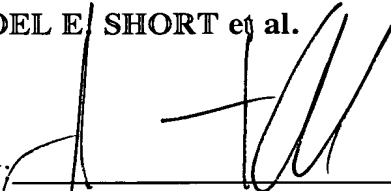
The claim term "automatically modifying packets" is indefinite and lacks support in the written description.

While this Statement is being filed in compliance with the duty of disclosure, citation of the listed references is not to be construed as an admission that any of the references are "material" as defined under 37 C.F.R. § 1.56(b).

Respectfully submitted,

JOEL E. SHORT et al.

By:


James N. Kallis
Reg. No. 41,102
Attorney for Applicant

Date: March 31, 2005

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Application No.	09/684,937
Filing Date	October 6, 2000
First Named Inventor	Joel E. Short
Art Unit	2664
Examiner	Patel, Ajit
Attorney Docket No.	NOMI 0119 PUS

Multiple sheets used when necessary)

SHEET 1 OF 2

NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ¹
	1	Network Working Group Request For Comments: 826 - Ethernet Address Resolution Protocol (November, 1982)	
	2	Network Working Group Request For Comments: 894 - Standards For Transmission of IP Datagrams Over Ethernet Networks (April, 1984)	
	3	Network Working Group Request For Comments: 925 - Multi-LAN Address Resolution (October, 1984)	
	4	Network Working Group Request For Comments: 1009 - Requirements For Internet Gateways (June, 1987)	
	5	Network Working Group Request For Comments: 1027 - Using ARP to Implement Transparent Subnet Gateways (October, 1987)	
	6	Network Working Group Request For Comments: 1034 - Domain Names - Concepts and Facilities (November, 1987)	
	7	Network Working Group Request For Comments: 1531 - Dynamic Host Confirmation Protocol (October, 1993)	
	8	Network Working Group Request For Comments: 1919 - Classical Versus Transparent IP Proxies (March, 1996)	
	9	Network Working Group Request For Comments: 1945 - Hypertext Transfer Protocol - HTTP/1.0 (May, 1996)	
	10	L. Kleinrock, "Nomadic Computing" (Keynote address) <i>Int'l Conf. on Mobile Computing and Networking</i> , 1995, Berkeley, California, ACM.	
	11	M. Baker et al., "Supporting Mobility in MosquitoNet, Proceedings of the 1996 USENIX Technical Conference, San Diego, CA, January, 1996	
	12	Comer, "Internetworking With TCP/IP Vol. 1, Chapter 10, Principles, Protocols, and Architecture", 3 rd ed., Prentice Hall 1995	
	13	Joel E. Short: "Auto-Porting and Rapid Prototyping with Application to Wireless and Nomadic Network Algorithms, A dissertation submitted in partial satisfaction of the requirements for the degree of Doctor of Philosophy in Computer Science", University of California, Los Angeles; Published Oct. 26, 1996; pp. xv, 118-124; Copyright Jan. 16, 1997	
	14	Case No. 04CV1485 BTM (POR): IP3 Networks, Inc. v Nomadix, Inc. - 7/23/04 Complaint for: (1) Declaratory Judgment of Patent Non-Infringement and Invalidity of U.S. Patent No. 6,636,894; (2) Declaratory Judgment of Patent Non-Infringement of U.S. Patent No. 6,130,893; (3) Trade Libel; (4) Libel Under Cal. Civ. Code § 45; (5) Unfair Competition Under Cal. Bus. & Prof. Code § 17200, Et Seq.; and (6) Intentional Interference with Prospective Economic Advantage	
	15	Case No. 04CV1485 BTM (POR): IP3 Networks, Inc. v Nomadix, Inc. - 9/20/04 Amended Complaint for: (1) Declaratory Judgment of Patent Non-Infringement and Invalidity of U.S. Patent No. 6,636,894; (2) Declaratory Judgment of Patent Non-Infringement of U.S. Patent No. 6,130,893; (3) Trade Libel; (4) Libel Under Cal. Civ. Code § 45; (5) Unfair Competition Under Cal. Bus. & Prof. Code § 17200, Et Seq.; and (6) Intentional Interference with Prospective Economic Advantage - Demand for Jury Trial	

Examiner Signature

Date Considered

***Examiner:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

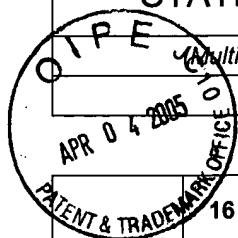
T¹ - Place a check mark in this area when an English language Translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Application No.	09/684,937
Filing Date	October 6, 2000
First Named Inventor	Joel E. Short
Art Unit	2664
Examiner	Patel, Ajit
Attorney Docket No.	NOMI 0119 PUS

(Multiple sheets used when necessary)

SHEET 2 OF 2



- | | | |
|----|---|--|
| 16 | Case No. 04CV1485 BTM (POR): IP3 Networks, Inc. v Nomadix, Inc. - 10/21/04 Answer and Counterclaims of Nomadix, Inc. to the Amended Complaint | |
| 17 | Case No. 04CV1485 BTM (POR): IP3 Networks, Inc. v Nomadix, Inc. - Plaintiff/Counter-Defendant IP3 Networks Inc.'s Reply to Defendant Nomadix, Inc.'s Counterclaim | |

1339583_1
031405

Examiner Signature

Date Considered

***Examiner:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

T¹ - Place a check mark in this area when an English language Translation is attached.